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PATENT
Attorney Docket No. 8267.0004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Henning HENNINGSSEN)
Serial No.: 09/402,751) Group Art Unit: 2674
Filed: October 12, 1999) Examiner: A. Zamani
For: AN APPARATUS AND A METHOD)
FOR ILLUMINATING A)
LIGHT-SENSITIVE MEDIUM)

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APR 08 2003

Assistant Commissioner for Patents
Washington, D.C. 20231

Technology Center 2600

Sir:

REQUEST FOR RECONSIDERATION

In reply to the Office Action dated October 3, 2002, the period for reply having been extended through April 3, 2003 by a Petition for Extension of Time of three (3) months and fee payment filed concurrently herewith, Applicant respectfully requests reconsideration based on the remarks which follow.

Initially, Applicant notes that the previous Office Action was sent to an attorney who is no longer empowered to act in this case. A Revocation of Power of Attorney and Grant of New Power of Attorney was filed in this case on January 16, 2002, a copy of which, along with a copy of the stamped postcard receipt from the PTO is attached. Applicant requests that further communications be forwarded to the current attorneys-of-record.

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In the previous Office Action, claims 1-3, 5, and 13-22 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,428,366 to Eichenlaub ("Eichenlaub"). In addition, claims 4, 6, and 9-12 were objected to as being dependent upon a rejected base claim, but were otherwise deemed drawn to allowable subject matter. Applicant expresses his appreciation for the indication of allowable subject matter in this case.

Applicant respectfully traverses the rejection of claims 1-3, 5, and 13-22 under § 103(a) for the following reasons.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8th ed. 2001)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must be found in the prior art, and not be based on applicant's disclosure. (See M.P.E.P. §2143 (8th ed. 2001)).

Regarding the §103(a) rejection of claims 1-3, 5, and 13-22 over Eichenlaub, Eichenlaub refers to a field sequential color illumination system for liquid crystal displays. The Examiner alleges that Eichenlaub discloses an illumination unit for point illumination of a medium comprising a plurality of light emitters, wherein a light valve arrangement comprising a plurality of controlled light valves where at least two of the light emitters are arranged to illuminate a plurality of light valves. (Office Action, para.

4.) To support the allegation of least two of the light emitters being arranged to illuminate a plurality of light valves, the Examiner points to the Abstract of Eichenlaub. However, it is respectfully submitted that the portion of the Abstract that the Examiner referred to is incomplete, misleading and at variance with Eichenlaub's full disclosure.

Eichenlaub's Abstract states: "A field sequential color illumination system for liquid crystal displays is described which focuses light from a plurality of small point like or line like light sources into **subregions of pixels** of an LCD by a fly's eye lens, in such a manner that at any given time, red, blue, and green light spots are focused simultaneously into different pixels. Furthermore, during each subsequent field, light spots are focused into different **sub sections of each pixel**. . ." (emphasis added.)

The Examiner's allegation that the Eichenlaub Abstract teaches at least two of the emitters being arranged to illuminate a plurality of light valves is clearly a misunderstanding as the Abstract specifically teaches that sub-regions of pixels of an LCD refer to sub-regions of the individual pixels and not to sub-regions comprised of the pixels. That Eichenlaub teaches illumination of different subregions of the individual light valves is substantiated repeatedly in the Eichenlaub specification (e.g., col. 3, ll. 4-5, "the light patterns illuminating selected sub regions of the elements of the light valve array") as well as in the claims, where it is stated (e.g., claim 1) that different "portions" of "each of the light valves" are illuminated in a sequential manner. This may also be appreciated when looking at both Figs. 7 and 9 of Eichenlaub, both showing a "one-to-one" relationship. One light source will therefore always illuminate the same pixel. For example, the blue lamp 82 in Fig. 7 illuminates a portion (less than 1/3) of the right one

of the three pixels via the fly's eye lens. In other words, none of the light emitters 80-88 of Eichenlaub illuminate a plurality of light valves; only one (and only a part of it!). Consequently, the arguments already stated in the pending application, i.e. that an illumination area may be subdivided into a number of sub-areas, which may be individually illuminated by a number of light emitters has not been revealed or indicated by Eichenlaub

Accordingly, Eichenlaub does not teach or suggest "[a]n illumination unit for point illumination of a medium comprising a plurality of light emitters comprised of light guides arranged to illuminate an illumination face via a light valve arrangement comprising a plurality of electrically controlled light valves, **each of at least two of the light emitters being arranged to illuminate a plurality of light valves**, as recited in independent claim 1. (emphasis added.) Because Eichenlaub does not teach or suggest each and every element recited in the claim 1, the §103(a) rejection of claim 1 should be withdrawn.

In addition, Applicant notes that the Examiner did not provide any suggestion or motivation to modify Eichenlaub in a manner resulting in the invention of claim 1, nor did he allege a reasonable expectation of success arising from such a modification. Because the Examiner also did not show motivation to modify or a reasonable expectation of success, the §103(a) rejection of claim 1 is improper and should be withdrawn.

Applicant respectfully points out to the Examiner that it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full

appreciation of what such reference fairly suggests to one of ordinary skill in the art.”
See *In re Wesslau*, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. §2141.02, p. 2100-120. Since Eichenlaub does not teach or suggest all the recitations of Applicant’s claimed invention, there can be no suggestion or motivation in Eichenlaub to modify it. One skilled in the art would only arrive at the present claimed invention by consulting Applicant’s disclosure. Therefore, the only way to construct the claimed invention from the cited reference would be to rely on aspects related to the present invention. Such reliance, however, would constitute improper hindsight reasoning. Applicant submits that the cited reference does not suggest the desirability of its modification to produce Applicant’s present invention.

Applicant takes issue with the Examiner’s allegation that “it would have been obvious to one of ordinary skill in the art to provide an illumination unit and a display system employing light valve apparatus which are simple in construction and stable in functioning at high reliability, and can be readily manufactur[ed] at low cost.” These generalized statements are of questionable relevance, and the Examiner does not provide any factual documentary evidence in support of this allegation of obviousness.

Applicants also contest the Examiner’s averments, quoted above, as Applicant has already demonstrated herein that the cited reference does not teach or suggest each and every element of Applicant’s independent claim 1, let alone the claims which depend therefrom.

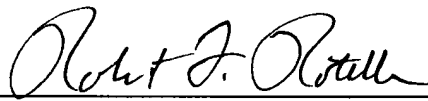
The §103(a) rejection of claims 2, 3, 5, and 13-19 should be withdrawn as well, at least in view of their dependence from allowable claim 1. The disposition of claims 7 and 8 was not addressed in the Office Action. However, those claims each depend

from claim 1 and are also allowable at least in view of such dependency. Finally, independent claim 20 includes recitations similar to that of allowable claim 1 and is allowable for the same reasons given above. Claims 21 and 22 depend from allowable claim 20 and are allowable at least by reason of such dependency.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

Robert F. Rotella
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Dated: April 2, 2003

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